RESPONSE UNDER 37 C.F.R. § 1.111
Appln. No.: 09/489,576

Attorney Docket No.: A8525
IBM Ref. No.: STL000013US1

(hereinafter "Helmick"), U.S. Patent No. 6,470,171. Applicant respectfully traverses the rejection.

Claim 1

McGraw-Hill is cited for teaching all elements of claim 1 except for "defining the first content object by a first outline of containers and content entity identifiers, such that adding the content entity identifier of one of the second plurality of content entities to the first outline adds the identified content entity to the first content object at a location determined by a user." The Examiner cites Helmick as disclosing that missing limitation. The Examiner asserts that the combination of Helmick with McGraw-Hill is obvious in order to build a custom hierarchical outline compilation of educational materials. However, as discussed below, McGraw-Hill and Helmick do not disclose all of the claimed elements. Further, there is no teaching or suggestion in the prior art to combine Helmick with McGraw-Hill as the Examiner asserts.

The Examiner asserts that the content to be placed in a customized book in McGraw-Hill can be mixed and matched in any order, therefore, McGraw-Hill discloses "*adding* the content entity identifier of one of the second plurality of content entities to the first list *adds the identified content entity* to the first content object *at a location determined by a user...* wherein the location determined by the user *is between the plurality of content entity identifiers*.

However, there is no indication in McGraw-Hill that a user determines the location of a content entity identifier when adding a content entity identifier of a second content entity to a first content object. Assuming *arguendo* McGraw-Hill discloses a customized book, the location of the content entity identifier added to the first content object is determined *subsequent to* the addition of the content entity identifier to the first content object. Upon the addition of a

title (content entity identifier as cited by the Examiner) to modular text files (first plurality of content entities as cited by the Examiner), the title is **not** added to a customized book (first content object as cited by the Examiner) at a location determined by a user **in which the location determined by a user is between the plurality of content entity identifiers**.

In McGraw-Hill, upon addition of a title to a customized book, it appears that the title is merely added to the end of titles selected by a user for a customized book. As indicated by the Examiner, the user then has the option of resequencing the content at a later stage.

In particular, the McGraw-Hill reference appears to show that a user browses for desired subject matter and then selects "Add" to add the content to their customized book. After adding the content, the user then has the option of reviewing the selected content and resequencing the content as necessary as shown by the "resequencing" control illustrated in the upper right hand corner of the figures. However, there is no teaching or suggestion that "*adding* the content entity identifier of one of the second plurality of content entities to the first list adds the identified content entity to the first content object *at a location determined by a user* wherein the location determined by the user *is between the plurality of content entity identifiers.*"

The Examiner further asserts that Helmick teaches an on-line education system for display of education materials wherein a user can use a course manager screen in order to build an electronic syllabus. Figs. 3V-3X of Helmick. The Examiner reasons that the combination of "defining a first object by a first list of content entity identifiers organized as an outline of containers such that adding the content entity identifier of one of the second plurality of content entities to the first list outline adds the identified content entity to the first content object at a location determined by a user" as allegedly disclosed in Helmick, with the teachings of McGraw-

Hill would be obvious to one of skill in the art for the motivational purpose of building a custom

hierarchical outline compilation of educational materials.

However, Figs. 3V-3X of Helmick cited by the Examiner do not disclose the relationship

between a first content object and a second content object as recited in claim 1. Fig. 3X shows

an "add contents screen" 1084 for use by an instructor to "add or modify content." However, the

content added to a syllabus as illustrated in Fig. 3V (which the Examiner appears to be citing for

teaching a first content object) is not a content entity identifier of one of a second plurality of

content entities but rather is the content itself. Accordingly, modifying McGraw-Hill based on

Helmick would result merely in providing McGraw-Hill with an "add contents screen" that

would allow an instructor to type in the actual content to be added. The combination would not,

however, add a content identifier of one of a second plurality of content entities to the first list

outline, as required by claim 1. Moreover, Helmick does not cure the deficiencies of McGraw-

Hill.

The Examiner asserts that "storing of the first plurality of content entities in a data

repository" is taught by the custom book of McGraw-Hill that is created by a user. However, as

previously asserted by the Applicant, there is no indication that the custom book created by a

user is stored in the Primis database (data repository as cited by the Examiner). In response to

Applicant's argument that although the customized entities of McGraw-Hill must be stored in

some kind of memory, there is no teaching or suggestion that the first plurality of content entities

(the customized book according to the Examiner) is stored in the data repository, namely, the

Primis database, as asserted in the Office Action, the Examiner "agrees that the customized book

does not "necessarily" <u>have</u> to be stored in the Primis database, although it can be." Further, the

Examiner states that it is commonly well known that a customized book must be stored in some kind of memory, therefore, the Examiner asserts that this limitation of the claims is therefore deemed inherent.

However, "[i]n relying upon the theory of inherency, the examiner must provide a basis in fact and/or technical reasoning to reasonably support the determination that the allegedly inherent characteristic *necessarily flows* from the teachings of the applied prior art." *Ex parte Levy*, 17 USPQ2d 1461, 1464 (Bd. Pat. App. & Inter. 1990). According to the Examiner's own statements, the customized book (first content object as cited by the Examiner) could be stored in locations other than the Primis database. Consequently, this aspect of the claim is not inherent.

For at least the above reasons, claims 1, 6, 16, 21, 31 and 36 and their dependent claims should be deemed allowable.

Claim 10

Claim 10 recites "wherein adding the first container to the first outline adds the content entities identified by the content entity identifiers of all containers in the first container to the first object." The Examiner asserts that McGraw-Hill teaches outlining textbooks into containers for the purpose of increasing the modularity of files for ease in creating a mixed and matched customized book. However, there is no teaching or suggestion is McGraw-Hill of adding a first container to a first outline. As illustrated in McGraw-Hill on, for example, page 9, titles are individually added to a user's book by selecting 'Add'. At no point does McGraw-Hill give a user the option of adding containers to a user's book.

For at least the above reasons, claim 10 should be deemed allowable. To the extent claims 25 and 40 recite similar elements, they should be deemed allowable for at least the same reasons.

Claim 15

Claim 15 recites "providing a user interface communicating with the data repository, and providing a mechanism for creating a new container to add to the first outline at a desired location through the user interface." The Examiner asserts that McGraw-Hill allows instructors to add their own created syllabus to a first outline at a desired location by uploading it through the user interface. However, a syllabus is not a container as initially asserted by the Examiner in rejecting claim 10. In rejecting claim 10, the Examiner asserts that the outlining of books teaches the claimed container. See Office Action at page 9. Moreover, a syllabus (container as cited by the Examiner) is not added to a first outline (customized book as cited by the Examiner) at a desired location through a user interface.

For at least the above reasons, claim 15 should be deemed allowable. To the extent claims 30 and 45 recite similar elements, claims 30 and 45 should also be deemed allowable for at least the same reasons.
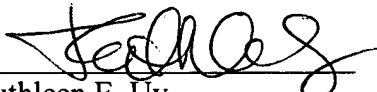
II.   Conclusion

In view of the above, reconsideration and allowance of this application are now believed to be in order, and such actions are hereby solicited. If any points remain in issue which the Examiner feels may be best resolved through a personal or telephone interview, the Examiner is kindly requested to contact the undersigned at the telephone number listed below.

The USPTO is directed and authorized to charge all required fees, except for the Issue

Fee and the Publication Fee, to Deposit Account No. 19-4880. Please also credit any

overpayments to said Deposit Account.

Respectfully submitted,

SUGHRUE MION, PLLC   Ruthleen E. Uy
Telephone: (202) 293-7060   Registration No. 51,361
Facsimile: (202) 293-7860

WASHINGTON OFFICE

· 23373

CUSTOMER NUMBER

Date: June 12, 2006